

## **REMARKS**

### **I. Introduction**

Claims 1 to 19 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 14 and 15 Under 35 U.S.C. § 112**

Claims 14 and 15 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Applicants respectfully submit that claims 14 and 15 fully satisfy the requirements of 35 U.S.C. § 112 for at least the following reasons.

The Office Action alleges that the term “end switch” is not clear and is not used in the Specification. The Office Action further alleges that it is not clear whether the term “bearing” refers to bearing 12’ or ball 10’. It appears that the present rejection is based on the misapprehension that the definiteness requirement requires that the words and phrases used in the claims must match those used in the Specification. There is no requirement that the words in the claim must match those used in the Specification. See, e.g., M.P.E.P. § 2173.05(e). Notwithstanding the above, Applicants respectfully submit that the term end switch would have been reasonably clear to one skilled in the art at the time of filing and that, contrary to the allegations in the Office Action, the Specification mentions an end switch at numerous locations. See, for example, p. 5, lines 7 to 16 and p. 6, lines 28 to 30. Applicants further respectfully submit that the term “bearing,” as used in claims 14 and 15, would have been sufficiently clear to one skilled in the art at the time of filing.

As stated in M.P.E.P. § 2173.02, the “focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision.” In this regard, the “essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” Id. (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[ inter alia, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” Id. If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and

scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more.

M.P.E.P. § 2173.05(a) (citing Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)). Based on the foregoing, it is respectfully submitted that the present claims are sufficiently definite. Withdrawal of this rejection is therefore respectfully requested.

### **III. Rejection of Claims 1 to 4 and 17 to 19 Under 35 U.S.C. §103(a)**

Claims 1 to 4 and 17 to 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,713,501 ("Yokoyama et al."), U.S. Patent No. 6,561,489 ("Wakefield"), U.S. Patent No. 6,701,913 ("LeDuc et al.") and U.S. Patent No. 6,712,171 ("Farmer"). Applicants respectfully submit that the combination of Yokoyama et al., Wakefield, LeDuc et al. and Farmer does not render unpatentable the present claims for at least the following reasons.

Yokoyama et al. purportedly relate to an automobile having a spare tire carrier with a lock mechanism including rear door bottom panel support. Wakefield purportedly relates to an automatic winch drive system. LeDuc et al. purportedly relate to a swingable apparatus attachable to a vehicle for transporting a cooking device and permitting access to the vehicle. Farmer purportedly relates to a refueling safety switch. Nowhere does the combination of Yokoyama et al., Wakefield, LeDuc et al. and Farmer disclose, or even suggest, at least one sensor configured to detect at least one position of a spare-wheel carrier and to transmit the at least one position to a control unit, the control unit configured to enable and block functions of a motor vehicle in accordance with the position of the spare-wheel carrier, as recited in claims 1 and 17, means for detecting at least one position of a spare-wheel carrier, means for enabling and blocking functions of a motor vehicle in accordance with the position of the spare-wheel carrier, and means for transmitting the position of the spare-wheel carrier from the detecting means to the enabling and blocking means, as recited in claim 18, or detecting at least one position of a spare-wheel carrier on a motor vehicle, the spare-wheel carrier pivotable at a body of the motor vehicle and arranged in a region of a tailgate of the motor vehicle and enabling and blocking functions of the motor vehicle in accordance with the position of the spare-wheel carrier, as recited in claim 19. Therefore, the combination of Yokoyama et al., Wakefield, LeDuc et al. and Farmer does not disclose, or even suggest, all of the features of claims 1 and 17 to 19.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of Yokoyama et al., Wakefield, LeDuc et al. and Farmer does not disclose, or even suggest, all of the features of claims 1 and 17 to 19. Therefore, Applicants respectfully submit that claims 1 and 17 to 19 are not rendered unpatentable by the combination of Yokoyama et al., Wakefield, LeDuc et al. and Farmer.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

The use of a sensor and computer system to shut down an engine when the fuel door is open does not render it unpatentable to disable or block a vehicle function when attempting to drive with an unlocked tire-carrier. The system of Farmer prevents a vehicle's engine from running while refueling so as to prevent ignition of fumes. Farmer does not disclose, or even suggest, disabling the engine when a fixture of the automobile, such as a tire carrier, is unlocked. Farmer does not even mention a tire-carrier. Nor do LeDuc et al. and Wakefield disclose, or even suggest, anything beyond notifying a driver that a cooking device and a tire suspended from the bottom of a vehicle are unlocked. None of the references disclose or even suggest taking any action, including disabling or blocking a vehicle function, in response to an unlocked fixture secured to an exterior of a vehicle other than notifying a driver that the fixture is unlocked via a display unit inside the vehicle. Farmer disables the vehicle's engine so as to prevent ignition of fumes not damage to the vehicle from an unlocked fixture connected to an exterior of the vehicle.

The Office Action over generalizes the description by Farmer. The Office Action states that "the sensor mechanism [of Farmer] is aimed to prevent the operation of a motor vehicle in an unsafe or hazardous condition based upon the positioning of an exterior vehicle component." This implies that the position of the fuel tank door is being sensed by Farmer because it may damage the car if left open while driving. However, Farmer does not describe any potential danger to the car if

the fuel tank door, or any other exterior fixture, swings while driving. Rather, the danger protected against by the Farmer system stems from driving with an open fuel tank, irrespective of the type of fuel tank cover, swinging cover or, for example, screw on cap, used to seal the tank. Farmer discloses a safety system that prevents a car from being driven while there is a danger of fume ignition. This in no manner suggests or provides any motivation for blocking functions of a motor vehicle depending on a position of a spare-wheel carrier. The Office Action's allegation to the contrary are apparently based merely upon conclusory hindsight and reconstruction, which, as detailed above, do not provide a proper basis for an obviousness rejection. Therefore, it is respectfully submitted that it would not have been obvious to modify the vehicle of Yokoyama et al. so as to include a modified version of the sensor systems of Wakefield and LeDuc et al. including the Farmer vehicle disabling feature.

In view of all of the foregoing, it is respectfully submitted that the combination of Yokoyama et al., Wakefield, LeDuc et al. and Farmer does not render unpatentable claims 1 to 4 and 17 to 19.

Claims 2 to 4 ultimately depend from claim 1 and therefore include all the features of claim 1. Accordingly, it is respectfully submitted that these dependent claims are allowable for at least the same reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

#### **IV. Allowed Claims 5 to 13**

Applicants note with appreciation the allowance of claims 5 to 13.

V. Conclusion

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

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Respectfully submitted,

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